

REMARKS

The foregoing amendment does not include the introduction of new matter into the present application for invention. Therefore, the Applicant, respectfully, requests that the above amendment be entered in and that the claims to the present application, kindly, be reconsidered.

The Office Action dated August 24, 2004 has been received and considered by the Applicants. Claims 1-8, 15 and 16 are pending in the present application for invention. Claims 1-8, 15 and 16 stand rejected by the August 24, 2004 Office Action.

The Office Action rejects Claims 1, 2, 8, 15 and 16 under the provisions of 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,349,086 issued to Nishida et al. (hereinafter referred to as Nishida et al.). The Examiner making the rejection states that Nishida et al. disclose a method of manufacturing a circular optical storage disc comprising: providing a substrate with a first surface and a periphery; providing a coating on the first surface by applying a liquid, rotating the substrate, and solidifying the liquid; and wherein applying the liquid onto the surface the substrate is present in a separate extension body (ring 20) the extension body having substantially circumferential contact with the periphery of the substrate, and having a surface substantially flush with the first surface of the substrate, as illustrated in Figures 12-15 and described in col. 11, lines 25-48; and after substantial solidification of the liquid, the extension body and the substrate are separated. The Examiner further states that it is known that substantial solidification of the liquid occurs in Nishida et al.'s process because solidification by UV curing occurs while ring 20 is still present around the substrate.

The Applicants would like to, respectfully, point out that the foregoing amendment to the claims has added the feature formerly recited in Claim 7 that the extension is formed from at least two parts. Nishida et al. do not disclose or suggest that

ring 20 can be formed from multiple parts. The Applicant respectfully submits that the above discussed amendment renders this rejection moot. Claims 2, 8, 15 and 16 depend from Claim 1, either directly or indirectly, and further narrow and defined Claim 1. Therefore, Claims 2, 8, 15 and 16 are also believed to be allowable.

The Office Action rejects Claims 3-7 under the provisions of 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,349,086 issued to Nishida et al. The Examiner making the rejection with regard to Claims 3 and 4 states that Nishida et al. lack a teaching that the outer periphery of the ring 20 has a polygonal, or regular polygonal shape. The Examiner's position is that it would have been obvious for one having ordinary skill in the art to use a non-circular ring/extension body, such as a square or hexagon or octagon with the expectation of achieving similar and equivalent results. The Applicant respectfully disagrees.

AS states in the MPEP at §2142, in order to "establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)." The Applicant, respectfully points out that no suggestion or motivation is provided within Nishida et al. for using a polygonal, or regular polygonal shape for the outer periphery in place of the ring 20. The Applicant, further points out that no reasonable expectation of success is provided within Nishida et al. for using a polygonal, or regular polygonal shape for the outer periphery in place of the ring 20. Additionally, the lack of any suggestion for using any type of polygonal or regular polygonal shape within Nishida et al. results in all the claimed limitations not being found within the cited reference Nishida et al. Moreover, the Office Action does not state how Nishida et al. provide any suggestion or reasonable expectation of success, both of which must be found within the cited prior art references. Accordingly, the Office Action does not establish a *prima facie* case of obviousness.

therefore, traversed.

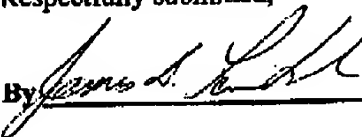
The Office Action rejects Claim 7 under the provisions of 35 U.S.C. §103(a) as being unpatentable over Nishida et al. (hereinafter referred to as Nishida et al.) as applied to Claims 1-6, 8 and 15-16, and further in view of U.S. Patent No. 6,012,858 issued to Konishi et al. (hereinafter referred to as Konishi et al.). The Examiner making the rejection states that Nishida et al lack a teaching of using a spin chuck/extension body which is comprised of two parts. The Examiner further states that Nishida et al. is alternatively rejected in view of Konishi et al. The Examiner states that Konishi et al disclose an extension body/liquid-receiving base 32 which forms a surface flush with the substrate surface similar to that used in Nishida et al. Additionally, the Examiner further states that Figure 17 of Konishi et al. demonstrates that a liquid-receiving base may be formed of two parts 32a and 32b. The Applicants, respectfully, disagree. There is no disclosure or suggestion within Konishi et al. that liquid receiving base is made out of two parts. Therefore, this rejection is respectfully traversed.

The foregoing amendment to the claims adds new Claims 17-19 that recites subject matter illustrated in Figures 2A, 2B and 2C and described on page 7 of the specification to the present invention. This subject matter relates to the sides used to form the extension body being congruent and the number of sides used in the polygonal shape used to form the extension body being equal to half the number of sides within the polygonal shape. This is subject matter not disclosed or suggested within the cited prior art references. Therefore, the subject matter of new Claims 17-19 is believed to be allowable.

Applicant is not aware of any additional patents, publications, or other information not previously submitted to the Patent and Trademark Office which would be required under 37 C.F.R. 1.99.

In view of the foregoing amendment and remarks, the Applicant believes that the present application is in condition for allowance, with such allowance being, respectfully, requested.

Respectfully submitted,

By 

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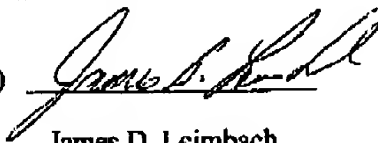
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